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09/882,788	06/15/2001	James K. Hawley	M 6675 MANCO	9982

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EXAMINER

EGAN, BRIAN P

ART UNIT PAPER NUMBER

1772

DATE MAILED: 10/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/882,788

Applicant(s)

HAWLEY ET AL.

Examiner

Brian P. Egan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 8-10, 12, 14-17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friedland et al. (#6,238,762) in view of Aoki et al. (#3,808,091).

Friedland et al. teach a synthetic shelf liner (see Abstract) comprising a sheet of synthetic film (Fig. 4, #32) having on a first side a layer comprising a silicone polymeric material (Fig. 4, #37) and having on a second side a layer of repositionable adhesive (Fig. 4, #34). The synthetic film layer comprises a polyolefin or a copolyolefin and may be copolypropylene (Col.3, lines 46-49). The synthetic liner may be in roll form and therefore comprises a continuous film (see Abstract). Although Friedland et al. do not explicitly state that the synthetic film layer is a synthetic paper, it is notoriously well known in the art that polyethylene, polypropylene, and copolymers thereof, are used to form synthetic paper as evidenced by Aoki et al. (Col. 3, lines 14-20). The repositionable adhesive comprises a pressure sensitive acrylic adhesive (Col. 4, lines 35-42). The synthetic shelf liner is applied to a shelf surface (Col. 2, lines 6-13 and 44-46) – shelf surfaces implicitly being horizontal. The synthetic shelf liner is in the form of a roll and does not contain a release sheet to prevent contact between the adhesive and the first surface of the shelf liner (Col. 4, lines 52-56; Col. 5, lines 58-64).

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3. Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friedland et al. ('762) in view of Aoki et al. ('091), and further in view of Shepherd (#6,025,058).

Friedland et al. and Aoki et al. teach a synthetic paper shelf liner as detailed above. The aforementioned prior art fails to explicitly teach the physical properties and thickness of the synthetic paper layer.

Shepherd, however, teaches a synthetic paper substrate that can be used for the purpose of providing an alternative to paper wherein durability and toughness are improved (Col. 1, lines 25-27) as well as demonstrating an improved printability over prior art synthetic papers (Col. 1, lines 37-47; Col. 2, lines 20-22). The synthetic paper comprises a polyolefin film base layer (Col. 2, lines 23-30). Depending on the desired end product, a pressure sensitive adhesive coating is applied to the surface of the base layer (Col. 4, lines 41-45). The thickness of the base layer is between 10 and 500 micrometers (Col. 3, line 6-8) wherein the film exhibits a tensile strength in the machine direction of 5203 pounds per square inch and 4842 pounds per square inch in the transverse direction (see Table 6). The base primarily comprises a copolymer of polyethylene (see Table 1) (note also that polyethylene and polypropylene are functionally equivalent as demonstrated by Aoki et al. (Col. 3, lines 14-20)). It would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have combined the aforementioned prior art with Shepherd since each of the aforementioned references are analogous insofar as being directed at synthetic polymeric substrate layers – Shepherd providing a comparative advantage over the aforementioned

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prior art insofar as providing a synthetic paper that is both durable and tough and comprises an improved printability.

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicants invention was made to have modified the aforementioned prior art to include a synthetic paper substrate as taught by Shepherd in order to provide an alternative to paper wherein durability and toughness are improved as well as demonstrating an improved printability over the prior art synthetic papers.

4. Claims 2, 11, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friedland et al. ('762) in view of Aoki et al. ('091), and further in view of Ito et al. (#4,623,587).

Friedland et al. and Aoki et al. teach a synthetic paper shelf liner as detailed above. The aforementioned prior art fails to teach the use of a tie coating between the synthetic paper and the layer of repositionable adhesive.

Ito et al., however, teach a multi-layered film material comprising an adhesive layer and a layer of polyethylene and polypropylene copolymers (see Abstract). The film further comprises a polyethyleneimine tie layer between the adhesive and polyolefin base layer for the purpose of increasing the strength of the adhesive bond to the base (Col. 8, lines 3-10). It would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have combined the teachings of the aforementioned prior art along with Ito et al. since each of the prior art references are analogous insofar as being directed at bonding an adhesive layer in combination with a synthetic polymer layer.

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Therefore, it would have been obvious to one of ordinary skill in the art at the time applicants invention was made to have modified the aforementioned prior art by adding a tie layer between the base and adhesive layer as taught by Ito et al. in order to increase the strength of the adhesive bond to the base.

5. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Friedland et al. ('762) in view of Aoki et al. ('091), and further in view of Scholz et al. (#6,074,747).

Friedland et al. and Aoki et al. teach a shelf liner as detailed above. Although Friedland et al. teach the use of a cured silicone release coating, Friedland et al. fail to teach the use of a crosslinked silicone polymer.

Scholz et al., however, teach the use of a continuous label substrate comprising a base layer coated on one side with a silicone release layer and coated on the opposite side with an adhesive layer (see Abstract). The silicone release layer is a cured silicone polymer comprising cross-linking agents (Col. 28, claim 31). Scholz et al. teach the specified release composition for the purpose of providing a release coating that is ink-imprintable (see Abstract). It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have combined the teachings of Friedland et al. and Scholz et al. since each of the aforementioned references are analogous insofar as being directed at continuous rolled adhesive substrates with cured silicone release coatings.

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to have modified Friedland et al. (and Aoki et al.) to

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include a crosslinked silicone release coating as taught by Scholz et al. in order to provide a release coating that is ink-imprintable.

### ***Response to Arguments***

6. Applicant's arguments filed August 11, 2004 have been fully considered but they are not persuasive.

The applicant's primary contention is that Friedland et al. fail to suggest that the polymeric sheet comprise a synthetic paper. The examiner respectfully disagrees. First, Friedland et al. teach that the synthetic film layer comprises a polyolefin or a copolyolefin and may be copolypropylene (Col.3, lines 46-49). Thus, the polymeric layer of Friedland et al. broadly encompasses any polyolefin or copolyolefin and specifically may comprise copolypropylene. A specific form of polypropylene is the synthetic paper detailed by Aoki et al. (Col. 3, lines 14-20). The applicant has defined "synthetic paper" as "a flexible, thin sheet of a composition comprising a synthetic polymer preferably a polyolefin or copolyolefin. The synthetic paper and the composite preferably contains substantially no wood or vegetable fibers" (Specification, p.3). Even by itself, the teachings of Friedland et al. read on the applicant's definition of synthetic paper. The examiner, however, has further emphasized that the synthetic film of Friedland et al. can be synthetic paper as taught by Aoki et al. Aoki et al. provides clear motivation in using the synthetic paper material insofar as the synthetic paper is free of surface patterns, rich in printability, and excellent in luster, appearance, and hand (Col. 2, lines 3-6). Furthermore, the test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170

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USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA 1969). Here, not only does Friedland et al. alone suggest the use of a synthetic paper shelf liner as defined by the applicant, Aoki et al. provide further support and motivation in using a synthetic paper material.

Second, the applicant asserts that because synthetic paper was known for at least 30 years before the invention but never used as a shelf liner, the invention is not obvious. The examiner respectfully disagrees. First, the recitation of a new intended use for an old product does not make a claim to that old product patentable. *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997). Furthermore, the examiner maintains that the combination of Friedland et al. and Aoki et al. taken as a whole fairly suggests the use of a synthetic paper substrate as a shelf liner.

Third, the applicant asserts that there must be some common thread which connects the references to provide a basis for the rejection over Friedland et al., Aoki et al., and Shepherd and the requisite thread is lacking. The examiner respectfully disagrees. First, there is no requirement that a common thread run through each reference. Rather, as stated above, the test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA 1969). It has been held that one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references. *In re Keller*, 208 USPQ 871 (CCPA 1981). Nonetheless,



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each of the aforementioned references detail synthetic polymeric materials and therefore there is a common thread running through the three references. Further, there is clear motivation in modifying Friedland et al. and Aoki et al. with the synthetic paper of Shepherd, namely in order to provide an alternative to paper wherein durability and toughness are improved as well as demonstrating an improved printability over the prior art synthetic papers.

Finally, the applicant asserts that there is no motivation to combine the teachings of Ito et al. with Friedland et al. and Aoki et al. The examiner respectfully disagrees. As noted in the previous office action and above, there is a clear motivation expressed by Ito et al. to include a tie layer between an adhesive and a polymeric layer in order to increase the strength of the adhesive bond to the base. Again, the test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). Here, the fact that Ito et al. may or may not suggest the use of synthetic paper is irrelevant. Ito et al. broadly teach the use of a tie layer between an adhesive layer and a synthetic polymeric layer to improve adhesive. The combination of references, taken as a whole, fairly suggest the use of a tie layer in combination with a synthetic paper layer which, as defined by the applicant, is a synthetic polymeric layer preferably of a polyolefin or copolyolefin.

For the foregoing reasons, the examiner maintains the rejections set forth in the previous office action and directs the applicant's attention to the new grounds of rejection detailed above in relation to newly added claims 18 and 19.

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7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

#### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Egan whose telephone number is 571-272-1491. The examiner can normally be reached on M-F, 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
BPE 10/25/04

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
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10/26/04